

41
In re Patent Application of

HERSHFIELD et al.

Serial No. 09/762,097

Filed: August 23, 2001

Title: URATE OXIDASE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty Dkt. 1579-527

Group Art Unit: 1652

Examiner: Patterson

Date: November 7, 2003

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Special Program Examiner Julie Burke
Director, Technology Center 1600

Sir:

**REQUEST FOR RECONSIDERATION
AND RENEWED PETITION UNDER RULE 181**

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☐ **Correspondence Address Indication Form Attached.**

Fees are attached as calculated below:

Total effective claims after amendment	0	minus highest number		
previously paid for	20	(at least 20) =	0 x \$ 18.00	\$ 0.00

Independent claims after amendment	0	minus highest number		
previously paid for	3	(at least 3) =	0 x \$ 86.00	\$ 0.00

If proper multiple dependent claims now added for first time, add \$290.00 (ignore improper)	\$ 0.00
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Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$420.00/2 months; \$950.00/3 months)	\$ 0.00
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Terminal disclaimer enclosed, add \$ 110.00	\$ 0.00
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<input type="checkbox"/> First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$770.00)	\$ 0.00
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☐ Please enter the previously unentered, filed

☐ Submission attached

Subtotal \$ 0.00

If "small entity," then enter half (1/2) of subtotal and subtract	-\$ 0.00
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☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00)	\$ 0.00
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Assignment Recording Fee (\$40.00)	\$ 0.00
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Other:	0.00
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TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
BJS:

NIXON & VANDERHYTE P.C.
By Atty: B. J. Sadoff, Reg. No. 36,663

Signature: _____

In re Patent Application of

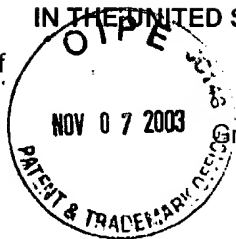
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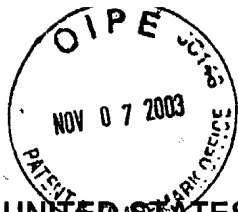
TOTAL FEE ENCLOSED \$ 0.00

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**REQUEST FOR RECONSIDERATION
AND RENEWED PETITION UNDER RULE 181**

Reconsideration of the Decision on Petition mailed September 10, 2003, in the above is requested for the following reasons.

The Decision indicates that a Request for Reconsideration of the Decision must be "made by way of a renewed petition". See, page 3 of the Decision. The present paper should be treated as a renewed Petition and a request for reconsideration.

The Patent Office is authorized to charge the undersigned's Deposit Account No. 14-1140 for any required fee for consideration of this Request. There are no fees believed to be required however the Patent Office is requested to advise the undersigned if otherwise.

The Applicants filed a Rule 181 Petition on April 15, 2003, which requested that the Commissioner invoke his supervisory authority and have the restriction requirement of November 27, 2001, withdrawn. The remarks of the Rule 181 Petition filed April 15, 2003, are of record and the Applicants believe that the contents of the same should not need to be repeated herein. To the extent required, the comments of the Rule 181 Petition filed April 15, 2003, are incorporated herein by reference and the attachments thereto are similarly incorporated.

The Decision dated September 10, 2003, granted-in-part the Rule 181 Petition filed April 15, 2003, in that the restriction requirement of November 27, 2001, has been "removed". The Decision indicates that

"The polypeptides will be examined together with the method of use. However, claims directed to polynucleotides are not rejoined to the polypeptides because these inventions are not linked by a special technical feature which makes a contribution over the prior art." See, page 3 of the Decision.

Specifically, the Decision indicated that a restriction requirement between claims 2-5 and 6-17 "drawn to recombinant chimeric uricase proteins and methods of increasing non-deleterious PEG attachment site on uricase proteins" and claims 6-15 "drawn to polynucleotides, vectors and host cells encoding the recombinant chimeric uricase proteins" was appropriate because the subject matter of these groups of claims "lack the same or corresponding special technical feature". See, page 2 of the Decision. The following reason was given as a basis for the finding that the subject matter of these groups of claims lack the same or corresponding technical feature:

Miura et al., (of record [European Journal of Biochemistry, 223, 141-146 (1994)]) teaches a recombinant chimeric uricase protein which has been modified to insert one or more lysine residues wherein said protein has two or more mammalian amino acid sequences (see abstract in particular), thereby teaching Applicant's invention as presently recited in claim 2. Since Applicant's inventions do not contribute a special technical feature when viewed over the prior art they do not have single general inventive concept and lack unity of invention." See, page 2 of the Decision.

The Examiner has determined however in an Office Action mailed October 24, 2003, that the claims, including claim 2, are patentable over "Mura et al." (see, page 3 of the Office Action dated October 24, 2003 (Paper No. 21)), which the Applicants believe is a reference to the Miura et al. reference cited as the basis in the Decision for the holding of an alleged lack of unity of invention.

As the Examiner has now affirmed that the claims of Group I recited on page 2 of the Decision are patentable over the art, the basis for the restriction requirement asserted in the Decision no longer supports maintaining the restriction requirement. Accordingly, the Commissioner is requested to instruct the Examiner to consider all of the claimed subject matter and issue a new action in place of the Office Action mailed October 24, 2003.

As the date for responding to the Office Action dated October 24, 2003, is January 24, 2004 (with further extensions possible), the Commissioner is requested to act expeditiously on the present Renewed Request for Reconsideration so that the Applicants will be advised of the status of the application and any outstanding requirement prior to the January 24, 2004, due date for responding to the Office Action mailed October 24, 2003.

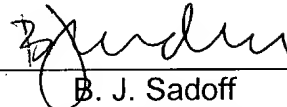
HERSHFIELD et al.
Serial No. 09/762,097
November 7, 2003

Reconsideration of the Decision is requested along with a new Office
Action on the merits of all the claimed subject matter.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



B. J. Sadoff
Reg. No. 36,663

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